

REMARKS/ARGUMENTS

Favorable reconsideration of this Application, as presently amended and in light of the following discussion, is respectfully requested.

This Amendment is in response to the Office Action mailed on September 1, 2004. Claims 1-10 are pending in the Application and Claim 10 stands rejected. Claims 1-9 have been allowed. The indication of allowed subject matter is noted with appreciation. Claims 1-10 are amended by the present Amendment for better compliance with U.S. standard practice.

Applicants respectfully bring to the Attention of the Examiner that an IDS filed on this Application on April 2, 2002 has not been acknowledged in its entirety (page 1 of that IDS was not returned with acknowledgement). If necessary, Applicants are in a position to resubmit copies of that IDS and the date-stamped filing receipt, documenting that the IDS was properly filed on that date. Applicants respectfully request the Examiner to inform Applicants' representatives at the earliest convenient time about the need to resend copies of the IDS filing documents.

Summarizing the outstanding Office Action, Claim 10 was rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 1 of Maurice et al. (U.S. Patent No. 5,796,710, hereinafter "Maurice"). Applicants respectfully traverse this rejection because Claim 1 of Maurice does not disclose all of the features recited in Claim 10 of the instant application.

Claim 10 recites a recording medium comprising, among other features, several tracks recordable in parallel, each track comprising a preamble zone recorded or recordable in parallel, each preamble zone containing data making it possible to locate the tracks one with respect to the others, wherein the preamble zones contain data with nonzero continuous components, and the tracks are distributed in groups containing data

with positive continuous components which alternate with groups of tracks with negative continuous components.

Claim 1 of Maurice recites:

“Information recording medium in which the information elements are recorded in tracks located side by side, in which on each track the information elements are encoded, characterized in that the encoding of first identified tracks is done so that said first identified tracks have a continuous component with a first value while the encoding of second tracks of the recording medium is done so that said second tracks have a continuous component with a second value different from said first value wherein each one of said first identified tracks is in an alternating relationship with each one of said second tracks to form said side by side tracks.”

As disclosed in the MPEP §804(II)(B)(1), “a double patenting rejection of the obviousness type is analogous to a failure to meet the nonobviousness requirement of 35 U.S.C. §103.”<sup>1</sup> Applicants respectfully submit that Claim 10 is not made obvious by Claim 1 of Maurice because every feature recited in Claim 10 is not taught or suggested by Maurice. The outstanding Office Action asserts that the difference between the two structures is simply the designation of a plurality of tracks as a group of tracks. Applicants respectfully disagree. In fact, Applicants respectfully submit that the outstanding Office Action is devoid of any evidence or a substantial explanation of how Claim 1 of Maurice makes obvious the invention of Claim 10 of this Application.

The recording medium recited in Claim 10 features a group of tracks in which each track comprises a preamble zone recorded or recordable in parallel with data making it possible to locate one track with respect to the others, the preamble zones containing nonzero continuous component data, and the tracks being distributed in groups containing data with positive continuous components which alternate with groups of tracks with negative continuous components.

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<sup>1</sup> *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967).

In Maurice, the information recording medium is comprised of recorded tracks located side by side. First identified tracks is encoded with a continuous component having a first value while second tracks are encoded with a continuous component with a second value different from the first value where each one of the first identified tracks is in an alternating relationship with each one of the second tracks to form the side by side tracks.

Maurice does not teach or disclose recorded or recordable preamble zones with data that make it possible to locate one track with respect to the others. As such, Maurice cannot support a prima facie case of obviousness of the invention recited in Claim 10 of this Application.

In rejecting a claim under 35 U.S.C. 103(a), the USPTO must support its rejection by "substantial evidence" within the record,<sup>2</sup> and by "clear and particular" evidence.<sup>3</sup> As discussed above, neither substantial evidence, nor a clear and particular explanation, has been provided in support of the outstanding obviousness rejection of Claim 10. Therefore, Applicant requests that such substantial evidence be provided or that the rejection of Claim 10 be withdrawn.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1-10 is earnestly solicited.

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<sup>2</sup> In re Gartside, 203 F3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000) (holding that, consistent with the Administrative Procedure Act at 5 USC 706(e), the CAFC reviews the Board's decisions based on factfindings, such as 35 U.S.C. § 103(a) rejections, using the 'substantial evidence' standard because these decisions are confined to the factual record compiled by the Board.)

<sup>3</sup> In re Dembiczak, 175 F3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, although 'the suggestion more often comes from the teachings of the pertinent references.' The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular." ) (emphasis added).

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Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicants' undersigned representatives at the below listed telephone number.

Respectfully submitted,

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